

IN THE MATTER OF AN OPPOSITION by Collagen Corporation  
to application No. 633,825 for the trade-mark ZINADERM filed by  
Technilab Inc.

On June 8, 1989, Technilab Inc. filed an application to register the trade-mark ZINADERM based upon proposed use of the trade-mark in Canada in association with "produits pharmaceutiques, nommément: crème dermatologique contenant 5% d'oxide de zinc".

The opponent, Collagen Corporation, filed a statement of opposition on May 7, 1990 in which it alleged that the applicant's trade-mark ZINADERM is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant's trade-mark is confusing with the opponent's registered trade-mark ZYDERM, registration No. 280,336 covering protein composition for dermal implantation, which had been previously used in Canada.

The applicant submitted a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Rees M. Orland, Senior Vice President of the opponent, while the applicant submitted the affidavit of Fereydoun Chafai, Director of Scientific Development of the applicant. As evidence in reply, the opponent filed a second affidavit of Rees M. Orland.

Both parties submitted written arguments and neither party requested an oral hearing.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be the date of my decision (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538 (TMOB)). The material dates with respect to the non-entitlement and non-distinctiveness grounds are respectively the applicant's filing date (June 8, 1989) and the date of opposition (May 7, 1990).

In determining whether there would be a reasonable likelihood of confusion between the applicant's trade-mark ZINADERM and the registered trade-mark ZYDERM, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue.

While the opponent has not filed a copy of its registration referred to in its statement of opposition as evidence, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of the registration relied upon by the opponent (see Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd., 11 C.P.R. (3d) 410). In doing so, I noted that registration No. 280,336 for the trade-mark ZYDERM is still in force and covers wares identified as "protein composition for dermal implantation".

With respect to the inherent distinctiveness of the trade-marks at issue, I consider that both the applicant's trade-mark ZINADERM and the opponent's trade-mark ZYDERM as applied to the respective wares of the parties are inherently distinctive when considered in their entireties although the suffix DERM in both instances may suggest to some consumers a type of product for the skin.

Having regard to the evidence of the parties, both the extent to which the trade-marks have become known in Canada and the length of use of the marks favour the opponent in this opposition. In particular, the first Orland affidavit evidences in excess of \$2,100,000 (expressed in U.S. dollars in the Orland affidavit) in sales of its ZYDERM protein composition in Canada from 1983 to 1990. On the other hand, the applicant's application is based upon proposed use of its trade-mark ZINADERM in Canada and it is unclear from the Chafai affidavit whether the applicant had commenced use of its trade-mark in this country as of the date of Mr. Chafai's affidavit. Even if the applicant had commenced use of its mark, there is certainly no information provided by Mr. Chafai from which I could conclude that the applicant's trade-mark ZINADERM has become known to any measurable extent in Canada.

As for the wares of the parties and their respective channels of trade, both the applicant's dermatological cream and the opponent's protein composition for dermal implantation are products for the skin although the applicant's cream would be applied to the skin's surface while the opponent's product would be injected by syringe. However, the opponent's wares are sold to members of the medical profession who use the ZYDERM implants for their patients. As well, booklets explaining the opponent's ZYDERM implants are provided to members of the medical profession for distribution to their patients. On the other hand, the applicant's ZINADERM dermatological cream would be available to the average consumer through pharmacies. As a result, the channels of trade associated with the respective wares of the parties differ.

In the second Orland affidavit filed by way of reply evidence, the affiant states the following in paragraphs 2 to 11 of his affidavit:

The second Orland affidavit has not been challenged by way of cross-examination, nor did the

applicant seek leave to file further evidence which might have contradicted the statements made by Mr. Orland.

With respect to the degree of resemblance between the trade-marks at issue, the marks ZYDERM and ZINADERM bear some similarity in appearance and a somewhat greater degree of similarity in sounding. Further, to the extent that both marks may suggest to some consumers an association with the skin, the trade-marks also bear some similarity in the ideas suggested by them.

In view of the above, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark ZINADERM as applied to dermatological cream and the opponent's registered trade-mark ZYDERM as applied to protein composition for dermal implantation. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF June, 1993.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.